Remarks

The Office Action mailed January 4, 2005 and made final has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Applicants and the undersigned wish to express their appreciation to Examiner Borissov for the courtesies he extended during a telephone interview that occurred on May 5, 2005. Applicants were represented during the telephone interview by Daniel M. Fitzgerald and Charles Livingston.

During the telephone interview, the Office Action dated January 4, 2005 was discussed. More specifically, the undersigned discussed the Section 101 rejection of Claims 1-49 and the Section 102 rejection of Claims 50-118. With respect to the Section 101 rejection, the Examiner suggested that Applicants amend independent Claims 1 and 47-49 to include "technological arts" performing certain recited steps of the process, namely steps that include "processing", "computing", "calculating", or "transmitting", etc. Applicants have amended independent Claims 1 and 47-49 to include "technological arts" (e.g., a computer) performing certain steps of the recited process. Accordingly, Applicants respectfully submit that Claims 1-49 satisfy Section 101.

For example, Claim 1 recites "...deploying the acquired software asset including installing the acquired software asset on at least one of the server system and the at least one client system, the deployed software asset is accessed using the at least one client system...auditing the acquired software asset by...transmitting data from the server to the at least one client system to display an assessment worksheet on the at least one client system, the worksheet including at least one question relating to the acquired software asset...processing at the server at least one response received from the user to the at least one question displayed...and calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions

of the software license corresponding to the acquired software asset." Applicants therefore request that the Section 101 rejection be withdrawn.

With respect to the Section 102 rejection of Claims 50-84 and 86-118, the Examiner asserted that independent Claims 50 and 114-118 include "non-functional language" and that the Examiner would give "no patentable weight" to this language. The Examiner further indicated that the "non-functional language" includes the recitations after the words "said server system further configured to". Applicants traversed this assertion and respectfully submitted that the claim language "said server further configured to" does not render the recitations non-functional, but rather, this language describes the functionality that the server system is configured to perform. Accordingly, Applicants submitted that the language included in Claims 50 and 114-118 relating to the server was clearly functional language as described in MPEP 2106, and therefore, this language should be given full patentable weight.

The Examiner suggested that Applicants could overcome the Section 102 rejection of Claims 50-84 and 86-118 by amending independent Claims 50 and 114-118 to be in means plus function form. Applicants have amended Claims 50 and 114-118 as suggested by the Examiner.

The foregoing Amendment has been made in consequence of the Examiner Interview. Accordingly, Applicants respectfully submit that the present patent application is in condition for allowance.

Claims 1-5, 7-23, 25-84, and 86-118 are pending in this application. Claims 1-5, 7-23, 25-84, and 86-118 stand rejected. Claims 10 and 69 are objected to. Claims 24 and 85 have been canceled herein.

In accordance with 37 C.F.R. 1.136(a), a two month extension of time is submitted herewith to extend the due date of the response to the Office Action dated January 4, 2005, for the above-identified patent application from April 4, 2005, through and including June 4, 2005. In accordance with 37 C.F.R. 1.17(a)(3), authorization to charge a deposit account in the amount of $450.00 to cover this extension of time request also is submitted herewith.

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The objection to Claims 10 and 69 for certain informalities is respectfully traversed. Specifically, Claims 10 and 69 have been amended to recite a "*business* unit's name" (emphasis added). Accordingly, Applicants respectfully request the objection to Claims 10 and 69 be withdrawn.

The rejection of Claims 1-23 and 25-49 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is respectfully traversed.

The Office Action asserts at page 2 that method Claims 1-23 and 25-49 are rejected under Section 101 because the claimed invention "is directed to non-statutory subject matter" and "is not within the technological arts." Applicants respectfully traverse this assertion. However, Applicants have amended independent Claims 1 and 47-49 to address the rejection set forth in the Office Action for Claims 1-23 and 25-49.

With respect to Claim 1, Applicants submit that the claims of the present patent application are directed to practical applications in the technological arts. "Any sequence of operational steps can constitute a process within the meaning of the Patent Act so long as it is part of the technological arts." *In re Musgrave*, 431 F.2d 882 (C.C.P.A. 1970). For example, independent Claim 1 is a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system. Applicants submit that managing software assets is a useful process that is considered to be within "the technological arts ".

Applicants further traverse the assertion included in the Office Action that Claims 1-23 and 25-49 are directed to non-statutory subject matter under Section 101 in light of the "Examination Guidelines for Computer-Related Inventions". The Examination Guidelines for Computer-Related Inventions provides in relevant part as follows:

> In order to determine whether the claim is limited to a practical application of an abstract idea, Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure, Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post-manipulation activity....Only when the claim is devoid of any limitation to a

practical application in the technological arts should it be rejected under § 101. Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

Applicants respectfully submit that Claim 1 is limited to a practical application in the technological arts. Furthermore, Applicants respectfully submit that the Office Action does not expressly state how the language of Claim 1 supports the Section 101 rejection.

Claim 1 has been amended. Claim 1 recites a "method for managing software assets of a business entity". Thus, Applicants submit that Claim 1 is directed to a useful process that is considered to be within "the technological arts". Furthermore, Claim 1 recites "a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system." The method includes "deploying the acquired software asset including installing the acquired software asset on at least one of the server system and the at least one client system, *the deployed software asset is accessed using the at least one client system*...and auditing the acquired software asset by...*transmitting data from the server to the at least one client system to display an assessment worksheet on the at least one client system*, the worksheet including at least one question relating to the acquired software asset...*prompting a user to respond to the at least one question displayed on the at least one client system...processing at the server at least one response received from the user to the at least one question displayed*...and *calculating at the server a sigma value based at least in part on the at least one response received from the user*, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset." (Emphasis added). Thus, Claim 1 uses a server system and/or a client system to perform certain steps of the process. Claim 1 is therefore directed to a practical application in the technological arts.

The Office Action asserts at page 21 that "the examiner stipulates that claims 1-23 and 25-49 are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever" and "[t]he claims are no more than a suggested idea of identifying, acquiring and distributing required

software, and are completely devoid of any means to carry out the process." Applicants respectfully disagree. Claim 1 recites, for example, "deploying the acquired software asset including installing the acquired software asset on at least one of the server system and the at least one client system, the deployed software asset is accessed using the at least one client system" and "maintaining the acquired software asset including reviewing the software license and installing updated software on at least one of the server system and the at least one client system when provided by the software license". Moreover, Claim 1 recites "auditing the acquired software asset by: transmitting data from the server to the at least one client system to display an assessment worksheet on the at least one client system, the worksheet including at least one question relating to the acquired software asset...prompting a user to respond to the at least one question displayed on the at least one client system...processing at the server at least one response received from the user to the at least one question displayed...and calculating at the server a sigma value based at least in part on the at least one response received from the user."

Applicants submit that these recitations of Claim 1 that include "using at least one of the server system and a client system," among others, positively recite a limitation in the technological arts. Moreover, Claim 1 recites, in the preamble, "a web-based system including a server system coupled to a centralized database and at least one client system." The Office Action does assert at page 22 that "mere recitation in the preamble (i.e., intended or field of use) [of] a network system, or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble." However, Applicants submit that the recitations of Claim 1 that include "using at least one of the server system and a client system", among others, breathe life and meaning into the portion of the preamble that recites "a web-based system including a server system coupled to a centralized database and at least one client system."

The Office Action also asserts at pages 21 and 22 that Claims 1-23 and 25-49 are directed to non-statutory subject matter because "the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the

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invention in the technological arts" and "there does not appear to be any physical transformation of data." Applicants respectfully disagree. For example, as discussed above, amended Claim 1 recites using a server system, a client system and a database. Applicants submit that these recitations of Claim 1, among others, describe a computer (the servers system and/or the client system) being used to transform data from one form to another.

For at least the reasons set forth above, Claim 1 is submitted to be directed to a practical application in the technological arts. Accordingly, Applicants respectfully submit that Claim 1 satisfies the requirements of Section 101.

Dependent Claims 2-5, 7-23, and 25-46 depend from independent Claim 1, and these dependent Claims are submitted to satisfy the requirements of Section 101 for the same reasons set forth above with respect to independent Claim 1.

With respect to Claims 47-49, Applicants respectfully submit that Claims 47-49 are directed to practical applications in the technological arts for similar reasons to those set forth above with respect to Claim 1. Accordingly, Applicants respectfully submit that Claims 47-49 satisfy the requirements of Section 101.

For at least the reasons set forth above, Applicants respectfully request that the Section 101 rejection of Claims 1-23 and 25-49 be withdrawn.

The rejection of Claims 50-84 and 86-118 under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 5,845,065 (Conte) is respectfully traversed.

Applicants respectfully submit that Conte does not describe or suggest the claimed invention. As discussed below, at least one of the differences between Conte and the present invention is that Conte does not describe or suggest a web-based system including means for auditing the acquired software asset by transmitting data from a server to a client system to display an assessment worksheet on the client system, wherein the worksheet includes at least one question relating to the acquired software asset, prompting a user to respond to the at least one question displayed on the client system, processing at the server at least one response

received from the user to the at least one question displayed, and/or calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Conte describes a license compliance apparatus for controlling operation of remote networked devices, such as computers, in compliance with licensed restrictions. The license restrictions allow access to a predetermined number of users to a specific application. The license compliance apparatus determines whether a distribution exists which would result in access to the specific application for the requesting user and all current users. In one embodiment, licenses are assigned to users in the order of application requests that are made. When a request is made and no licenses are available, an analysis is performed to determined whether licenses may be swapped in such a fashion so as to free up a license for the requested application.

Claim 50 recites a web-based system for managing software assets of a business entity, wherein the business entity has a software management process, and the system includes a client system, a centralized database for storing information, and a server system configured to be coupled to the client system and the centralized database, wherein the web-based system further includes "means for identifying at least one software asset satisfying a predetermined requirement of the business entity...means for initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...means for prompting a user to deploy the acquired software asset including installing the acquired software asset on at least one of the server system and the client system, the deployed software asset is accessed using the client system...means for storing in the database information relating to each the acquired software asset including storing terms and conditions of a corresponding software license...means for maintaining the acquired software asset including prompting the user to review the software license and installing updated software on at least one of the server and the client system as provided by the software license...means for prompting the user to retire the

acquired software asset when the acquired software asset is no longer required by the business entity including de-installing the acquired software asset...and means for auditing the acquired software asset by...transmitting data from the server to the client system to display an assessment worksheet on the client system, the worksheet including at least one question relating to the acquired software asset...prompting the user to respond to the at least one question displayed on the client system...processing at the server at least one response received from the user to the at least one question displayed...and calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset."

As an initial matter, the Office Action asserts at page 8 that Claim 50 includes recitations that are "non-functional language" and are therefore "given no patentable weight." Additionally, the Office Action asserts at page 8 that claims "Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function" and at pages 8 and 9 that "[a] claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim." In the telephone interview, Applicants traversed this assertion and respectfully submitted that the claim language "said server further configured to" does not render the recitations non-functional, but rather, this language describes functionality that the server is configured to perform. Accordingly, Applicants submitted that the language included in Claims 50-84 and 86-118 relating to the server was clearly functional language as described in MPEP 2106, and therefore, this language should be given full patentable weight. The Examiner suggested that Applicants could overcome the Section 102 rejection of Claims 50-84 and 86-118 by amending independent Claims 50 and 114-118 to be in means plus function form. Accordingly, despite Applicants belief that the language included in Claims 50 and 114-118 should be given full patentable weight, Applicants have amended Claims 50 and 114-118 as suggested by the Examiner.

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Claims 51-84 and 86-113 depend from independent Claim 50. Applicants respectfully submit that the recitations of Claims 51-84 and 86-113 are entitled to full patentable weight for at least the same reasons as Claim 50.

Furthermore, Conte does not describe or suggest each of the recitations of Claims 50-84 and 86-118. Claim 50 is recited above. Conte does not describe or suggest a web-based system for managing software assets of a business entity as recited in Claim 50. For example, Conte does not describe or suggest a web-based system including means for auditing the acquired software asset by transmitting data from a server to a client system to display an assessment worksheet on the client system, wherein the worksheet includes at least one question relating to the acquired software asset, prompting a user to respond to the at least one question displayed on the client system, processing at the server at least one response received from the user to the at least one question displayed, and/or calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Rather, Conte describes a license compliance apparatus for controlling operation of remote networked devices, such as computers, in compliance with licensed restrictions. However, Conte does not describe nor suggest means for auditing the acquired software asset by transmitting data from a server to a client system to display an assessment worksheet on the client system, wherein the worksheet includes at least one question relating to the acquired software asset, means for auditing the acquired software asset by prompting a user to respond to the at least one question displayed on the client system, means for auditing the acquired software asset by processing at the server at least one response received from the user to the at least one question displayed, and/or means for auditing the acquired software asset by calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the

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business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Additionally, Conte does not describe or suggest a web-based system that includes means for identifying at least one software asset satisfying a predetermined requirement of the business entity, as recited in Claim 50. Although the Office Action asserts on page 13 that Conte describes "identifying at least one required software (C. 7, L. 3-15)," Applicants respectfully disagree. Rather, at col. 7, lines 3-15 Conte describes a database containing entries (records) for application licenses and the assigned/unassigned status of each. Conte describes at col. 7, lines 3-15 that each record contains a number of fields including "the name of the suite (if any), the license number (to be used when more than one license is available), the names of the applications and an identification of the users who are using the various applications."

Furthermore, Conte does not describe or suggest means for initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement, as recited in Claim 50. Although the Office Action asserts on page 13 that Conte describes "conducting acquisition process" at col. 6, lines 39-43, Applicants respectfully disagree. Rather, at col. 6, lines 39-43 Conte describes that a user "requests launch of application A1 and in response, the network license system of this invention assigns the A1 license to U1 [the user]". Further, at col. 6, lines 43-45 Conte further describes that "the [network license] system generates a signal to launch the requested program." In other words, in contrast to means for initiating and completing an acquisition process of a software asset, as recited in Claim 50, Conte describes a system configured to grant a user a license to use an application when the user tries to launch (run) the application, and launch the program after the license has been granted.

Moreover, Conte does not describe or suggest means for prompting a user to deploy the acquired software asset including installing the acquired software asset on at least one of a server system and a client system, as recited in Claim 50. Although the Office Action asserts on page 13 that Conte describes "deploying said identified software (C. 6, L. 39-43)," Applicants respectfully disagree. Rather, as discussed above, at col. 6, lines 39-43 Conte describes that a

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user "requests launch of application A1 and in response, the network license system of this invention assigns the A1 license to U1 [the user]" and further, at col. 6, lines 43-45, that "the [network license] system generates a signal to launch the requested program." In other words, in contrast to what is claimed in the present invention (i.e., means for prompting a user to deploy the acquired software asset including installing the acquired software asset on at least one of a server and a client system), Conte describes a system configured to grant a user a license to use an application when the user tries to launch (run) the application, and launch the program after the license has been granted.

Even further, Conte does not describe or suggest means for storing in a database information relating to the acquired software asset including storing terms and conditions of a corresponding software license, as recited in Claim 50. The Office Action asserts on page 13 that Conte describes "storing information relating to software owned or licensed by a business entity" at col. 6, lines 63-65. At col. 6, lines 63-65 Conte describes that the network license system "determines if there are any unassigned licenses available for the requested application" and further at lines 65-67 that "[i]n one embodiment, this is done by maintaining a database containing entries for each of the application licenses available and the assigned/unassigned status for each license." Conte describes at col. 7, lines 3-15 that each entry contains a number of fields including "the name of the suite (if any), the license number (to be used when more than one license is available), the names of the applications and an identification of the users who are using the various applications." However, Conte does not describe or suggest that the entries include terms and conditions of a software license. Accordingly, Conte does not describe or suggest means for storing in a database information relating to the acquired software asset including storing terms and conditions of a corresponding software license.

Additionally, as admitted in the Office Action at page 13, Conte does not describe or suggest means for maintaining the acquired software asset including prompting a user to review the software license and installing updated software on at least one of a server and a client system as provided by the software license, nor means for prompting the user to retire the acquired software asset when the acquired software asset is no longer required by the business

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entity including de-installing the acquired software asset. Although the Office Action asserts at page 13 that Conte describes "unassigning (retiring) software (C. 15, L. 31-33)," Applicants respectfully disagree. Rather, at col. 15, lines 31-33 Conte describes that the network license system "unassigns the license assignments...returning them to the license pool." Accordingly, Conte does not describe or suggest de-installing a software asset.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 50 is patentable over Conte.

Claims 51-84 and 86-113 depend from independent Claim 1. When the recitations of Claims 51-84 and 86-113 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 51-84 and 86-113 likewise are patentable over Conte.

Claim 114 recites a software license management system to automate a software management process for managing software assets of a business entity, measuring compliance requirements, and tracking/reporting status as necessary to assure proficiency and adherence to implementation requirements of the software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the centralized database, wherein the management system further includes "means for organizing and processing information using at least one of an a software identification module, an acquisition module, a deployment module, a maintenance module and a software retirement module...means for displaying an assessment worksheet on the client system, the worksheet including a plurality of questions relating to a software asset of the business entity...means for prompting a user to respond to the assessment worksheet including the plurality of questions relating to the software asset of the business entity...means for computing a sigma value based on the user's responses to the plurality of questions to measure compliance with the software management process including compliance with software licenses associated with the software asset...and means for providing feedback and suggestions based on the computed sigma value to help reduce the exposure to litigation and penalties, maximize software asset utilization through tighter inventory control, and capitalize on the software procurement process."

Conte does not describe or suggest a software license management system as recited in Claim 114. More specifically, Conte does not describe or suggest a management system including means for computing a sigma value based on a user's responses to a plurality of questions to measure compliance with the software management process including compliance with software licenses associated with the software asset. Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users, but as discussed above, Conte does not describe or suggest means for computing a sigma value based on a user's responses to a plurality of questions to measure compliance with the software management process including compliance with software licenses associated with the software asset.

Furthermore, Conte does not describe or suggest a management system that includes means for organizing and processing information using at least one of an a software identification module, an acquisition module, a deployment module, a maintenance module and a software retirement module, means for displaying an assessment worksheet on the client system wherein the worksheet includes a plurality of questions relating to a software asset of the business entity, means for prompting a user to respond to the assessment worksheet including the plurality of questions relating to the software asset of the business entity, and/or means for providing feedback and suggestions based on a computed sigma value to help reduce the exposure to litigation and penalties, maximize software asset utilization through tighter inventory control, and capitalize on the software procurement process.

Accordingly, Conte does not describe or suggest a software license management system as recited in Claim 114.

Claim 115 recites a system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the database, wherein the system further includes "means for accessing the centralized database containing software assets information including data relating to each software asset owned or

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licensed by the business entity including terms and conditions of each corresponding software license...means for searching the database regarding a specific inquiry received from a user...means for retrieving information from the database...means for causing the retrieved information to be displayed for tracking, monitoring and auditing purposes...means for auditing each software asset owned or licensed by the business entity by...transmitting data for a selected software asset from the server to the client system to display an assessment worksheet, the worksheet including at least one question relating to the selected software asset...prompting a user to respond to the at least one question displayed on the client system...processing at the server at least one response received from the user to the at least one question displayed...and calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the selected software asset."

Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 115. More specifically, as discussed above with respect to Claim 50, Conte does not describe or suggest a system that includes means for auditing each software asset owned or licensed by a business entity by transmitting data for a selected software asset from the server to the client system to display an assessment worksheet wherein the worksheet includes at least one question relating to the selected software asset, prompting a user to respond to the at least one question displayed on the client system, processing at the server at least one response received from the user to the at least one question displayed, and/or calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the selected software asset.

Moreover, Conte does not describe or suggest a system that includes means for accessing a centralized database containing software assets information including data relating to each software asset owned or licensed by the business entity including terms and conditions of each

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corresponding software license, and/or means for searching the database regarding a specific inquiry received from a user.

Accordingly, Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 115.

Claim 116 recites a system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the database, wherein the system further includes "means for displaying on the client system for a user a software management assessment checklist including a series of questions relating to a software asset owned or licensed by the business entity...means for receiving responses entered by the user through the client system to each question included within the software management assessment check list...means for computing a sigma value based on guidelines pre-stored within the database, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with software licenses associated with the software asset."

Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 116. More specifically, Conte does not describe or suggest a system that includes means for computing a sigma value based on guidelines pre-stored within the database, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with software licenses associated with the software asset. Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. However, Conte does not describe or suggest means for computing a sigma value based on guidelines pre-stored within the database, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with software licenses associated with the software asset.

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Moreover, Conte does not describe or suggest means for displaying on a client system for a user a software management assessment checklist including a series of questions relating to a software asset owned or licensed by a business entity, nor means for receiving responses entered by the user through the client system to each question included within the software management assessment check list.

Accordingly, Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 116.

Claim 117 recites a system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the system includes a client system, a centralized database, a server system configured to be coupled to the client system and the centralized database, wherein the system further includes "means for storing in the database information relating to a software asset owned or licensed by the business entity including storing terms and conditions of a corresponding software license...means for displaying on the client system an assessment worksheet including questions relating to the software asset...means for receiving user input in response to the assessment worksheet...means for analyzing user input against a pre-determined criteria...means for outputting a sigma value based on the user input and the pre-determined criteria, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset."

Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 117. More specifically, Conte does not describe or suggest a system that includes means for outputting a sigma value based on user input and pre-determined criteria, wherein the sigma value indicates compliance with a software management process of a business entity including compliance with terms and conditions of a software license corresponding to the acquired software asset. Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. However, Conte does not describe or suggest means

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for outputting a sigma value based on user input and pre-determined criteria, wherein the sigma value indicates compliance with a software management process of a business entity including compliance with terms and conditions of a software license corresponding to the acquired software asset.

Moreover, Conte does not describe or suggest means for storing in a database information relating to a software asset owned or licensed by the business entity including storing terms and conditions of a corresponding software license, means for displaying on a client system an assessment worksheet including questions relating to the software asset, means for receiving user input in response to the assessment worksheet, and/or means for analyzing user input against a pre-determined criteria.

Accordingly, Conte does not describe or suggest a system for tracking software assets owned and licensed by a business entity as recited in Claim 117.

Claim 118 recites a computer system for tracking software assets owned and licensed by a business entity, the business entity having a software management process, the computer system includes a client system, a centralized database, a server system configured to be coupled to the client system and the centralized database, wherein the computer system includes "means for receiving and storing information from a user as well as receiving a request for specific information from the user, the information received from the user including responses to specific questions relating to a software asset owned or licensed by the business entity...means for processing the received information and analyzing the received information against a pre-determined range of management criteria to satisfy the user request...means for downloading the requested information to the user including a sigma value indicating compliance with the software management process of the business entity."

Conte does not describe or suggest a computer system for tracking software assets owned and licensed by a business entity as recited in Claim 118. More specifically, Conte does not describe or suggest a computer system that includes means for downloading requested information to a user including a sigma value indicating compliance with a software

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management process of a business entity. Rather, Conte describes a license compliance apparatus for allowing access to a requesting user to a specific application by determining whether a distribution exists which would result in access to the specific application for the requesting user and all current users. However, Conte does not describe or suggest means for downloading requested information to a user including a sigma value indicating compliance with a software management process of a business entity.

Moreover, Conte does not describe or suggest means for receiving and storing information from a user as well as receiving a request for specific information from the user, the information received from the user including responses to specific questions relating to a software asset owned or licensed by the business entity, and/or means for processing the received information and analyzing the received information against a pre-determined range of management criteria to satisfy the user request.

Accordingly, Conte does not describe or suggest a computer system for tracking software assets owned and licensed by a business entity as recited in Claim 118.

For at least the reasons set forth above, Applicants request that the Section 102 rejection of Claims 50-84 and 86-118 be withdrawn.

The rejection of Claims 1-5, 7-17, 19, 25-34, and 37-47 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of U.S. Patent No. 6,735,701 (Jacobson) is respectfully traversed.

Conte is described above. Jacobson describes a policy effectiveness system for maintaining security and use policy compliance on a computer network. The system electronically monitors network user compliance with a network security policy stored in a database, electronically evaluates network security policy compliance based on network user compliance, and electronically undertakes a network policy compliance action in response to network security policy compliance. The network policy compliance actions include electronically implementing a different network security policy selected from network security

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policies stored in the database, generating policy effectiveness reports, and providing a retraining module to network users.

Claim 1 recites a method for managing software assets of a business entity using a web-based system including a server system coupled to a centralized database and at least one client system, the business entity having a software management process, wherein the method includes "identifying at least one software asset satisfying a predetermined requirement of the business entity...initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement...deploying the acquired software asset including installing the acquired software asset on at least one of the server system and the at least one client system, the deployed software asset is accessed using the at least one client system...storing in the centralized database information relating to the acquired software asset including storing terms and conditions of a corresponding software license...maintaining the acquired software asset including reviewing the software license and installing updated software on at least one of the server system and the at least one client system when provided by the software license...retiring the acquired software asset when the acquired software asset is no longer required by the business entity including de-installing the acquired software asset...and auditing the acquired software asset by...transmitting data from the server to the at least one client system to display an assessment worksheet on the at least one client system, the worksheet including at least one question relating to the acquired software asset...prompting a user to respond to the at least one question displayed on the at least one client system...processing at the server at least one response received from the user to the at least one question displayed...and calculating at the server a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset."

Neither Conte nor Jacobson, considered alone or in combination, describes or suggests a method for managing software assets of a business entity using a web-based system as recited in Claim 1. More specifically, as discussed above with respect to Claim 50, Conte does not

describe or suggest a method that includes auditing an acquired software asset by transmitting data from the server to the at least one client system to display an assessment worksheet on the at least one client system wherein the worksheet includes at least one question relating to the acquired software asset, prompting a user to respond to the at least one question displayed on the at least one client system, processing at the server at least one response received from the user to the at least one question displayed, and/or calculating at the server a sigma value based at least in part on the at least one response received from the user wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Jacobson also does not describe or suggest auditing an acquired software asset by transmitting data from the server to the at least one client system to display an assessment worksheet on the at least one client system wherein the worksheet includes at least one question relating to the acquired software asset, prompting a user to respond to the at least one question displayed on the at least one client system, processing at the server at least one response received from the user to the at least one question displayed, and/or calculating at the server a sigma value based at least in part on the at least one response received from the user wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Furthermore, neither Conte nor Jacobson, considered alone or in combination, describes or suggests initiating and completing an acquisition process of the at least one software asset satisfying the predetermined business requirement. Although the Office Action asserts at pages 13 and 14 that Jacobson describes purchasing software at col. 20, lines 50-51, Applicants respectfully disagree. Rather, at col. 20, lines 50-51 Jacobson describes tracking an organization's user access including tracking justification for software purchases, upgrades, and maintenance expense, software installations, software compliance, etc. Accordingly, Jacobson

does not describe or suggest initiating and completing an acquisition process of the at least one software asset satisfying a predetermined business requirement.

Moreover, neither Conte nor Jacobson, considered alone or in combination, describes or suggests storing in the centralized database information relating to the acquired software asset including storing terms and conditions of a corresponding software license. Furthermore, neither Conte nor Jacobson, considered alone or in combination, describes or suggests maintaining the acquired software asset including reviewing the software license and installing updated software on at least one of a server system and the at least one client system when provided by the software license. Although the Office Action asserts at pages 13 and 14 that Jacobson describes upgrading software at col. 20, lines 50-51, Applicants respectfully disagree. Rather, at col. 20, lines 50-51 Jacobson describes tracking an organization's user access including tracking justification for software purchases, upgrades, and maintenance expense, software installations, software compliance, etc.

Even further, neither Conte nor Jacobson, considered alone or in combination, describes or suggests retiring the acquired software asset when the acquired software asset is no longer required by the business entity including de-installing the acquired software asset.

Because neither Conte nor Jacobson teaches or suggests one or more of the claimed elements, it follows that a combination of Conte and Jacobson cannot teach or suggest such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte in view of Jacobson.

Claims 2-5, 7-17, 19, 25-34, and 37-47 depend from independent Claim 1. When the recitations of Claims 2-5, 7-17, 19, 25-34, and 37-47 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-5, 7-17, 19, 25-34, and 37-47 likewise are patentable over Conte in view of Jacobson.

Claim 47 recites a computer-implemented method for tracking software assets owned and licensed by a business entity using a computer coupled to a database, the business entity having a software management process, wherein the method includes "accessing the database containing

software assets information including data relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license...searching the database regarding a specific inquiry received from a user...retrieving information from the database...causing the retrieved information to be displayed on the computer for tracking, monitoring and auditing purposes...and auditing each software asset owned or licensed by the business entity by...transmitting data for a selected software asset from the database to the computer to display an assessment worksheet on the computer, the worksheet including at least one question relating to the selected software asset...prompting a user to respond to the at least one question displayed on the computer...processing at the computer at least one response received from the user to the at least one question displayed...and calculating at the computer a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the selected software asset."

Neither Conte nor Jacobson, considered alone or in combination, describes or suggests the method recited in Claim 47. Specifically, as discussed above with respect to Claim 1, neither Conte nor Jacobson, considered alone or in combination, describes or suggests a method that includes calculating a computer a sigma value based at least in part on at least one response received from a user wherein the sigma value indicates compliance with a software management process of a business entity including compliance with the terms and conditions of the software license corresponding to the selected software asset.

Furthermore, neither Conte nor Jacobson, considered alone or in combination, describes or suggests accessing a database containing software assets information including data relating to each software asset owned or licensed by the business entity including terms and conditions of each corresponding software license. The Office Action asserts on page 17 that Conte describes "accessing information from a license pool" at col. 7, lines 10-32. At col. 6, lines 63-65 Conte describes that the network license system "determines if there are any unassigned licenses available for the requested application" and further at lines 65-67 that "[i]n one embodiment, this

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is done by maintaining a database containing entries for each of the application licenses available and the assigned/unassigned status for each license." Conte describes at col. 7, lines 3-32 that each entry contains a number of fields including "the name of the suite (if any), the license number (to be used when more than one license is available), the names of the applications and an identification of the users who are using the various applications." However, Conte does not describe or suggest that the entries include terms and conditions of a software license.

Because neither Conte nor Jacobson teaches or suggests one or more of the claimed elements, it follows that a combination of Conte and Jacobson cannot teach or suggest such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 47 is patentable over Conte in view of Jacobson.

For at least the reasons set forth above, Applicants request that the Section 103 rejection of Claims 1-5, 7-17, 19, 25-34, and 37-47 be withdrawn.

The rejection of Claims 18 and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Jacobson and further in view of U.S. Patent No. 5,765,138 (Aycock) is respectfully traversed.

Conte and Jacobson are describe above. Aycock describes a supplier evaluation system that includes a database storing a plurality of maturity requirements and recognized quality standards, and a main processing system for compiling selected standards and quality maturity requirements in accordance with project objectives. The project requirements are supplied by a communication network to a supplier in the form of an interactive supplier self-evaluation system. The supplier self-evaluation system is arranged to include a plurality of objective questions corresponding to the selected maturity requirements. A supplier may selectively access local database files for information regarding the selected maturity requirements, or may remotely access the supplier evaluation system databases for supplemental information. After uploading the supplier responses to the supplier evaluation system, a supplier maturity level is calculated. An on-site supplier audit is thereafter conducted to confirm supplier responses and to obtain any additional information. Supplier approval is dependent upon a minimum supplier

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maturity level based upon the scored supplier responses to the maturity questions and the on-site audit.

Claims 18 and 20-23 depend from independent Claim 1, which is recited above. As discussed above, neither Conte nor Jacobson, considered alone or in combination, describes or suggests a method as recited in Claim 1. Aycock does not make up for the deficiencies of Conte and Jacobson. Because none of Conte, Jacobson, and Aycock teaches or suggests one or more of the claimed elements, it follows that a combination of Conte, Jacobson, and Aycock cannot teach or suggest such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte in view of Jacobson and further in view of Aycock.

Claims 18 and 20-23 depend from independent Claim 1. When the recitations of Claims 18 and 20-23 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 18 and 20-23 likewise are patentable over Conte in view of Jacobson and further in view of Aycock.

For at least the reasons set forth above, Applicants request that the Section 103 rejection of Claims 18 and 20-23 be withdrawn.

The rejection of Claims 35-36 under 35 U.S.C. § 103(a) as being unpatentable over Conte and Jacobson in view of U.S. Patent No. 6,477,471 (Hedstrom) is respectfully traversed.

Conte and Jacobson are both described above. Hedstrom describes a statistical tool apparatus for predicting defects in products that includes a processor, a memory, a keyboard, a drive for loading a software package and a display. The processor is loaded with a program for storing historical data indicating the historical pattern of defect containment in the stages of development. The processor has stored therein algorithms for computing sigma values based on opportunities and escaping defects in the stages, and includes an algorithm for backsolving from historical data. The apparatus provides historical data of defects at different stages of development and a value representing a goal for escaping defects. The apparatus also provides the planned total number of opportunities for defects. The goal for number of escaping defects

and the planned number of opportunities for defects are backsolved to determine the total number of defects. The total defects are distributed as a function of the historical data to provide prediction of defects at the different stages of development.

Claims 35-36 depend from independent Claim 1, which is recited above. As discussed above, neither Conte nor Jacobson, considered alone or in combination, describes or suggests a method as recited in Claim 1. Hedstrom does not make up for the deficiencies of Conte and Jacobson. The Office Action asserts at page 19 that Hedstrom "teaches a method and system for analyzing quality of the software development process, wherein the historical data, indicating defect containment in software development, is processed and sigma values are computed (C. 2, L. 34-38)" However, Hedstrom describes at col. 2, lines 34-38, that a processor has algorithms for computing sigma values based on historical defect data to predict defects in products. Accordingly, Hedstrom does not describe or suggest calculating a sigma value based at least in part on the at least one response received from the user, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset.

Because none of Conte, Jacobson, and Hedstrom teaches or suggests one or more of the claimed elements, it follows that a combination of Conte, Jacobson, and Hedstrom cannot teach or suggest such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 1 is patentable over Conte in view of Jacobson and further in view of Hedstrom.

Claims 35-36 depend from independent Claim 1. When the recitations of Claims 35-36 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 35-36 likewise are patentable over Conte in view of Jacobson and further in view of Hedstrom.

For at least the reasons set forth above, Applicants request that the Section 103 rejection of Claims 35-36 be withdrawn.

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The rejection of Claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Hedstrom is respectfully traversed.

Jacobson and Hedstrom are both described above.

Claim 48 recites a method for tracking software assets owned and licensed by a business entity using a web-based server system coupled to a database and at least one client system, the business entity having a software management process, wherein the method includes "displaying on the client system for a user a software management assessment check list including a series of questions relating to a software asset owned or licensed by the business entity...receiving at the server system responses entered by the user using the client system to each question included within the software management assessment check list...calculating a sigma value based on guidelines pre-stored within the database, the calculations are performed using the server system, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with software licenses associated with the software asset."

Neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a method for tracking software assets owned and licensed by a business entity as recited in Claim 48. More specifically, as admitted in the Office Action at page 20, Jacobson does not describe or suggest calculating a sigma value based on guidelines pre-stored within the database, the calculations are performed using the server system, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with software licenses associated with the software asset. Moreover, as discussed above, Hedstrom does not describe or suggest calculating a sigma value based on guidelines pre-stored within the database, the calculations are performed using the server system, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with software licenses associated with the software asset. Rather, Hedstrom describes a processor having algorithms for computing sigma values based on historical defect data to predict defects in products.

Additionally, neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a method that includes displaying on a client system for a user a software management assessment check list including a series of questions relating to a software asset owned or licensed by the business entity. Although the Office Action asserts at page 20 that Jacobson teaches "displaying on the client system a software management assessment list of questions related to software owned or licensed by the client (training feedback form)," at col. 20, lines 14-15, Applicants respectfully disagree. Rather, at col. 20, lines 14-15 Jacobson teaches that a user profile database includes a record of the user's policy training and exam status. Accordingly, Jacobson does not describe or suggest displaying on a client system for a user a software management assessment check list including a series of questions relating to a software asset owned or licensed by the business entity.

Because neither Jacobson nor Hedstrom teaches or suggests one or more of the claimed elements, it follows that a combination of Jacobson and Hedstrom cannot teach or suggest such elements. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 48 is patentable over Jacobson in view of Hedstrom.

Claim 49 recites a computer implemented method for tracking software assets owned and licensed by a business entity and providing a software management sigma value based on a pre-stored information, the business entity having a software management process, wherein the method includes "storing in a database information relating to a software asset owned or licensed by the business entity including storing terms and conditions of a corresponding software license...displaying on a computer system an assessment worksheet including questions relating to the software asset...receiving at the computer system user input in response to the assessment worksheet...analyzing user input against a pre-determined criteria...outputting from the computer system a software management sigma value calculated by the computer system based on the user input and the pre-determined criteria, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset."

Neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a computer-implemented method for tracking software assets owned and licensed by a business entity as recited in Claim 49. For example, as admitted in the Office Action at page 20, Jacobson does not describe or suggest a computer implemented method including outputting from the computer system a software management sigma value calculated by the computer system based on the user input and the pre-determined criteria, wherein the sigma value indicates compliance with the software management process of the business entity including compliance with the terms and conditions of the software license corresponding to the acquired software asset. Hedstrom does not make up for the deficiencies of Jacobson. Rather, Hedstrom describes a processor having algorithms for computing sigma values based on historical defect data to predict defects in products.

Moreover, neither Jacobson nor Hedstrom, considered alone or in combination, describe or suggest a computer-implemented method that includes storing in a database information relating to a software asset owned or licensed by a business entity including storing terms and conditions of a corresponding software license, displaying on a computer system an assessment worksheet including questions relating to the software asset, receiving at the computer system user input in response to the assessment worksheet, and/or analyzing user input against a pre-determined criteria.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 49 is patentable over Jacobson in view of Hedstrom.

For at least the reasons set forth above, Applicants request that the Section 103 rejection of Claims 48 and 49 be withdrawn.

In addition to the arguments set forth above, Applicants further submit that the rejection of Claims 1-5, 7-17, 25-34, and 37-47 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Jacobson; the rejection of Claims 18 and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Jacobson and further in view of Aycock; the rejection of Claims 35-36 under 35 U.S.C. § 103(a) as being unpatentable over Conte in view of Jacobson

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and further in view of Hedstrom; and the rejection of Claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Jacobson in view of Hedstrom are further traversed on the grounds that these rejections are not proper rejections.

Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Conte using the teachings of any of Jacobson, Hedstrom or Aycock, or to modify Jacobson in view of Hedstrom. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.
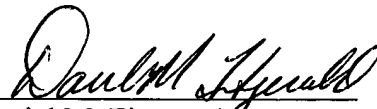
None of Conte, Jacobson, Hedstrom or Aycock, considered alone or in combination, describe or suggest the claimed combination. Rather, these present Section 103 rejections are based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Since there is no teaching, suggestion or motivation for the combination of Conte, Jacobson, Hedstrom or Aycock, these Section 103 rejections appear to be based on a

hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the rejection of Claims 1-5, 7-17, 25-34, and 37-47, the rejection of Claims 18 and 20-23, the rejection of Claims 35-36, and the rejection of Claims 48-49 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejections be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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